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09/901,472	07/09/2001	Peter K. Kassab	3404 P 005	6545

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EXAMINER

MAKI, STEVEN D

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/901,472

Applicant(s)

KASSAB, PETER K.

Examiner

Steven D. Maki

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6,11-14,16 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16 is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,11-14 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

- 1) The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 2) Claims 12, 14 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 12, the scope and meaning of "top coat" is unclear - a coat of what?

Claims 14 and 22 are indefinite because it is unclear how the description of "static-cling sticker assembly" in the preamble affects the subject matter of the body of the claim which describes low tack adhesive instead of static cling film. In each of claims 14 and 22, it is suggested to delete --static-cling-- before "sticker assembly" on line 1.

- 3) The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

- 4) Claim 12 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In claim 12, the subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention is the subject matter of "top coat". Page 26 describes "top-coat" but fails to define and /or describe the top coat. No

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composition(s) for the topcoat are identified. The purpose of the top coat is not described. The original disclosure fails to adequately describe "top-coat" and thereby fails to enable the subject matter claim 12. On pages 16 and 22 of applicant's response, applicant states: "The top coat improves the bond between the sticker and the vinyl film and is disclosed at page 26, lines 10-11 of the specification as filed". Page 26 lines 10-11 does not describe the top coat as being for improving the bond.

5) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

German '696

6) **Claims 1, 2, 4, 5, 6, 11, 13, 14 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over German '696 (DE 29720696) in view of Courtney (US 5622389) and Japan '014 (JP 9-97014) and optionally further in view of at least one the admitted prior art (specification pages 1-3, page 18 lines 12-17), Great Britain '233 (GB 2174233) and Langen (US 5290067).**

German '696, directed to a sticker for a car window, discloses sticking a "sticker" on a "window sticker removing aid" (mounting aid). The window sticker removing aid (mounting aid) consists of a "transparent foil" (transparent film), which has a "sticky layer" / "adhesive layer" on one side. The adhesive force of the sticky layer is lower than the adhesive force of the sticker. Hence, German '696 discloses a **sticker assembly** comprising:

sticker for car window

adhesive coating ("strong adhesive")

transparent film

adhesive layer ("low tack adhesive")

wherein the adhesive force of the adhesive layer on the film is lower than the adhesive force of the adhesive coating of the sticker. German '696 teaches that the sticker assembly *allows easy and complete removal of the sticker from the window without any problem and residue*. German '696's sticker assembly, therefore, is adapted to be releasably adhered to the car window. Since German '696 teaches that the mounting aid can be used to detachably adhere a common sticker to a car window or window at home, one of ordinary skill in the art would readily understand that the sticker has an indicia bearing surface as claimed. See abstract and translation. Hence, German '696 substantially discloses the claimed invention. German '696 is silent as to the edges of the film being in registry with (i.e. matching) the peripheral edges of the sticker.

As to claims 1 and 2, it would have been obvious to one of ordinary skill in the art to trim the film (a mounting sheet which is used to releasably mount the sticker to a window surface), such that the edges of the film are in registry with the edges of the sticker since (1) German '696's teaching to use the film as a releasable mounting aid for a sticker indicates that the film should have a shape and size matching that of the sticker / the adhesive coating on the sticker and (2) Courtney teaches adhering a sticker on a mounting sheet (which is used to releasably mount the sticker to a surface) and trimming the mounting sheet to match the shape and size of the sticker *so that the*

mounting sheet is virtually undetectable to the casual viewer and potential for theft is reduced by the appearance of permanent affixation (col. 1 lines 61-62, col. 2 lines 24-28, 3-31, 33-46, 50-55). Furthermore, it would have been obvious to one of ordinary skill in the art to use vinyl for the transparent film of German '696 since vinyl is a known transparent resin to one of ordinary skill in the sticker art as evidenced for example by Japan '014. The above rejection constitutes a prima facie case of obviousness. No further modification of German '696 is required by claims 1 and 2.

As to the "adhesive layer on the sticker", "direct contact", "fixedly attaching":

The claimed adhesive layer on the sticker reads on German '696's adhesive having the greater adhesive force. In any event: It would have been obvious to one of ordinary skill in the art to use a sticker having a strong adhesive as the sticker of German '696 such that the strong adhesive is in direct contact with the film and fixedly attaches the sticker to the film since (a) German '696, directed to the sticker art, teaches directly adhering a sticker on transparent film such that the adhesive force of the sticker is greater than the adhesive force of the sticky layer of the window sticker removing aid and (b) a sticker for a car window having a strong adhesive on one side for permanent bonding is well known per se in the sticker art as evidenced by the admitted prior art. Hence, German '696 suggests strongly bonding a sticker to the surface of a transparent film (mounting aid) and the admitted prior art teaches using a strong adhesive on a sticker for strongly bonding the sticker on a surface. It is acknowledged that the admitted prior art discloses directly sticking the sticker to the window. However, German '696 teaches

sticking the sticker directly on the mounting aid so that the sticker is indirectly and releasably adhered to the window.

As to the "low tack adhesive layer": The claimed low tack adhesive layer reads on German '696's adhesive layer the low adhesive force. In any event: The limitation of the adhesive layer being low tack so as to permit releasable adherence / peeling without damage would have been obvious to one of ordinary skill in the art in view of (a) German '696's teaching that the adhesive force of the adhesive layer is lower than the adhesive force of the adhesive coating on the sticker so that the adhesive assembly may be easily removed from the window and optionally (b) Great Britain '233's teaching to use an adhesive having a "lesser degree of adhesion" so a sticker assembly can be removed from a window and/or Langen's teaching to use a repositionable adhesive, such as that manufactured by 3M for Post-It® notes, for a sticker for a window so that the sticker may be removed from the window without leaving adhesive residue on the window. In Great Britain '233 (directed to a sticker assembly for a window), the adhesive for fixedly attaching is between a first side of transparent film 10 and an indicia bearing film 13 and the adhesive permitting removal of the sticker assembly from the window is on a second side of the transparent film 10 (see figure 9 of Great Britain '233). In Langen (directed to a sticker assembly for a window), the adhesive for fixedly attaching (the permanent adhesive 35) is between a first side of label stock 34 and label 12 and the adhesive for permitting removal of the sticker assembly from the window (the repositionable adhesive 36) is on a second side the label stock 34 (see figure 3 of Langen).

As to the indicia bearing surface being viewable through a receiving surface, one of ordinary skill in the art would readily understand that the sticker of German '696 has indicia viewable through a receiving surface since the sticker assembly of German '696 is for a car window. In other words, one of ordinary skill in the art would readily appreciate that the film is transparent in German '233 so that the sticker - including any indicia thereon- can be viewed through the transparent film and the window. In any event: It would have been obvious to one of ordinary skill in the art to provide the sticker of German '696's sticker assembly with an indicia bearing surface such that it can be viewed through a receiving surface (e.g. car window / windshield) in view of the admitted prior art's suggestion to view indicia of a sticker through the vehicle window and /or Great Britain '233's suggestion to view indicia (e.g. wording on item 13) of a sticker assembly through both the transparent film 10 of the sticker assembly and a vehicle window.

As to non-perforated / continuous, uninterrupted: German '696's transparent film is considered to be non-perforated, continuous and uninterrupted. In any event: It would have been obvious to provide German '696's transparent film as a non-perforated, continuous, uninterrupted transparent film since German '696, which fails to teach forming holes, teaches using the transparent film as a mounting aid for a sticker.

As to claims 4, 13, 14 and 22, it would have been an obvious alternative to use a pair of transparent film strips to cover a pair of adhesive strips instead of using one transparent film to cover a complete adhesive coating the entire surface of the sticker in view of (1) the above noted suggestion in German '696 to use transparent film having

low tack adhesive as a mounting aid for known stickers, (2) the admitted prior art's teaching that known stickers include temporary city stickers made from paper having a thin line of adhesive along the side of the sticker rather than a complete adhesive layer across the entire face of the sticker so that the adhesive is not provided over the indicia bearing portion (page 18 lines 12-17) and (2) Langen's suggestion to removably secure a sticker to window using spaced strips having repositionable adhesive wherein the indicia is not covered by the repositionable adhesive (figures 2 and 3). The limitation of trimming the strips / the trimmed strips would have been obvious in view of (a) the above noted suggestion from the applied prior art to use a pair of film strips instead of one film strip and (2) the above noted teaching to Courtney to trim the mounting sheet material to match the shape and size of the sticker *so that the mounting sheet is virtually undetectable to the casual viewer and potential for theft is reduced by the appearance of permanent affixation* (col. 1 lines 61-62, col. 2 lines 24-28, 3-31, 33-46, 50-55).

As to claim 5, the limitation therein would have been obvious in view of German '696's suggestion to use a foil, which is transparent.

As to claim 6, note examiner's comments on claims 1, 2 and 5 and Courtney's teachings regarding "undetectable".

As to claim 11, note examiner's comments on claim 2. With respect to the adhesive layer having a strength such that the film cannot be separated from the adhesive without destroying the film and the sticker, note German '696 and optionally the admitted prior art's teaching to use a relatively strong adhesive for the sticker.

7) Claims 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over German '696 in view of Courtney and Japan '014 and optionally further in view of at least one the admitted prior art, Great Britain '233 and Langen as applied above and further in view of Yoshida et al (US 4670490).

As to claim 12, it would have been obvious to use a "hard vinyl film" as the vinyl film since Yoshi et al suggests using a vinyl chloride resin having good pliability with moderate stiffness ("hard vinyl") for stickers. The "limitation" of the "top-coat" would have been obvious since (1) German '696 teaches adhering the film to the sticker and (2) it is taken as well known / conventional in the bonding art to coat a surface with a primer to improve bonding to another surface. Improved bonding would have been desired by German '696 since German '696 teaches removing the sticker assembly instead of only the sticker.

Langen

8) Claims 1, 2, 4, 11-14 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Langen in view of Honaker (US 4935288) or Yoshida et al.

Langen substantially discloses the claimed sticker assembly. See figure 2 and figure 3.

The claimed sticker reads on label 12, which has an "indicia bearing surface".

The claimed adhesive for attaching corresponds to permanent adhesive 35.

The claimed strips of vinyl film corresponds to strips 34 of label stock.

The claimed low tack adhesive reads on the repositionable adhesive 36.

Langen is silent as to the composition of the strips 34 of label stock.

As to claim 1 (sticker assembly), it would have been obvious to one of ordinary skill in the art to use vinyl film for the label stock used to form strips 34 since well known / conventional label stock includes vinyl label stock as evidenced for example by Honaker et al (col. 7 line 27) or Yoshida et al (e.g. col. 3 lines 9-20). The limitation of the vinyl film being non-perforate would have been obvious since Langen suggests using continuous uninterrupted non-perforate strips 34. As to the sticker assembly being adapted to be releasably adhered to a receiving surface, Langen teaches releasably adhering the sticker assembly to a window of a car. As to the film being trimmed, this product by process language in claim 1 fails to define structure different from that disclosed by Langen since the edges of the strips as in registry with edges 15, 16, 18 after slitting and bursting. See MPEP 2113. The same is true for product claims 12, 14 and 22. In claims 12 and 14, the edges of the strips are in registry with the edges of the label and therefore "undetectable" as claimed.

As to claim 2 (method), the limitation of the film being continuous, uninterrupted would have been obvious since Langen suggests using continuous uninterrupted non-perforate strips 34. The step of adhering the sticker to the film via the adhesive layer would have been obvious in view of Langen's suggestion to adhere the strips 34 to the label 12 using permanent adhesive; it being well known / conventional per se in the bonding art to apply adhesive to either or both of the surfaces to be bonded. As to the sticker assembly being releasably adhered to a windshield of a vehicle, Langen suggests releasably adhering the sticker assembly to a window (e.g. a side window) of

a car. In method claim 2, the claimed trimming step reads on the slitting and bursting for defining edges 15, 15, 18 described by Langen.

As to the remaining claims: As to claim 4, Langen suggests using two strips 34. In method claim 4, the claimed trimming step reads on the slitting and bursting for defining edges 15, 15, 18 described by Langen. As to claims 11 and 12, it would have been obvious to bond the strips 34 to the label 12 with an adhesive such that the strips 34 cannot be separated from the label without destroying the strips and the label in view of Langen's suggestion to bond the strips to the label with permanent adhesive. As to claim 12, Yoshida et al suggests "hard vinyl". The "limitation" of the "top-coat" would have been obvious since (1) Langen teaches using a permanent adhesive adhere strip 34 to label 12 and (2) it is taken as well known / conventional in the bonding art to coat a surface with a primer to improve bonding to another surface. In method claim 13, the claimed trimming step reads on the slitting and bursting for defining edges 15, 15, 18 described by Langen.

Allowable Subject Matter

9) **Claim 16 is allowed.**

The terminal disclaimer filed 3-1-04 is proper and has been recorded. Accordingly, the obvious type double patenting rejection over US 6258200 has been withdrawn.

Although the use of spaced strips of adhesive is known per se as shown by Langen (US 5290067) and Travis (US4536423), there is no motivation to modify the

static cling sticker assembly of Great Britain '256 so as to include the step of placing strips of static-cling film coinciding with the strips of adhesive; it being noted that (a) Great Britain '256, which does not disclose using strips of static-cling film, teaches covering the entire surface of the vehicle window sticker (printed sheet) with the static cling film and (b) Great Britain '551, which also does not disclose using strips of static cling material, teaches using a single static cling sheet (instead of the claimed strips of static cling film) to define an edge margin of static cling material for a vehicle windshield sticker.

Remarks

10) Applicant's arguments with respect to claims 1-2, 4-6, 11-14 and 22 have been considered but are moot in view of the new ground(s) of rejection. This action is non-final since the application of newly cited Courtney against independent claim 1 (but not independent claims 6, 12 and 14) was not necessitated by amendment.

Applicant's arguments filed 3-1-04 have been fully considered but they are not persuasive.

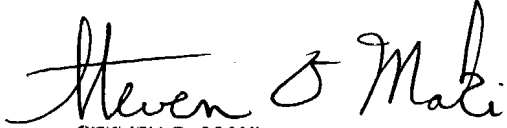
11) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven D. Maki whose telephone number is (571) 272-1221. The examiner can normally be reached on Mon. - Fri. 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Steven D. Maki
May 15, 2004


STEVEN D. MAKI
PRIMARY EXAMINER
~~GROUP 1300~~
Av 1733 / 5-15-04